

REMARKS

The Applicants acknowledge the first action on the merits for the pending case. Claims 1-25 are pending. The Applicants have amended paragraph 27 to attend to minor informalities. The Applicants have also amended Claims 1, 8, and 19 to incorporate the subject matter of Claims 7, 14, and 25, respectively, to point out that the upper and lower cover are pivotally mounted to the frame. Support for this amendment can be found in Fig. 1-2, and on pages 5-6, paragraph 19. Accordingly, the Applicants have cancelled claims 7, 14, and 25. No new matter has been added.

35 U.S.C. § 102 REJECTIONS

Claims 1-6, 8-13, and 19-24 have been rejected under 35 U.S.C. § 102(b) as anticipated by Maue U.S. Patent No. 5,995,380 (US'380). The Applicants submit that as a result of the amendment to Claims 1, 8, and 19, the rejection is now moot.

The Applicants have amended claims 1, 8, and 19 to incorporate the subject matter of Claims 7, 14, and 25, respectively. Claims 1, 8, and 19 now indicate that both the upper and lower covers are pivotally mounted on the frame. Fig. 1 shows an exemplary embodiment of the Applicants' invention, wherein the upper (7) and lower (8) covers are pivotally mounted to frame (5) to allow the covers (7 and 8) to articulate between an open to closed position. The Applicants respectfully submit that US '380 does not disclose a lower cover that is pivotally mounted to a frame. At best, US '380 only describes an upper cover that is pivotally mounted to a frame. In particular, Figs.1 and 2 of US '380 show a hinged plastic cover (45) that is pivotally mounted to only the "upper" housing 41. Nothing in US '380 describes a lower cover that is

pivotally mounted to a frame. Accordingly, the Applicants respectfully request withdrawal of the rejection of Claims 1-6, 8-13, and 19-24 as anticipated by US '380.

Claims 1-4, 8-11, and 19-22 have been rejected under 35 U.S.C. §102(b) as anticipated by Hamill U.S. Patent No. 5,207,587 (US '587). The Applicants submit that as a result of the amendment to Claims 1, 8, and 19 the rejection is now moot.

The Applicants respectfully submit that as a result of the amendment to Claims 1, 8, and 19 to indicate that both the upper and lower covers (7 and 8) are pivotally mounted, the rejection is now obviated. In particular, the Applicants respectfully submit that US '587 fails to disclose an upper or lower cover that is pivotally mounted to a frame. Accordingly, the Applicants respectfully request withdrawal of the rejection of Claims 1-4, 8-11, and 19-22 as anticipated by US '587.

35 U.S.C. § 103 REJECTION

Claims 7, 14-18 and 25 have been rejected as obvious in view of US '380. Claims 7, 14, and 25 have been cancelled. The rejection of these claims is now moot. The Applicants further submit that Claims 15-18 and the Applicants amended claims are not obvious in view of US '380.

The Office Action asserts that it would have been obvious to provide a hinge arrangement between a lower cover and a frame. In reaching this conclusion, the Office Action refers to St. Regis Paper Co. v. Bemis Co., Inc., 549 F.2d 833, 838 (7th Cir. 1977) to assert that the “mere duplication of essential working parts of a device involves only routine skill in the art.” This assertion is respectfully traversed, and the Applicants respectfully submit that reliance upon the above cited case for the rejection of the Applicants’ claimed invention is misplaced.

The court in St. Regis held that a “combination cannot be patented unless it is synergistic, that is, results in effect greater than sum of several effects taken separately.” A number of courts have criticized this holding as an improper measure of obviousness under the standards set forth by 35 U.S.C § 103.

In particular, courts have considered and rejected the notion that a new result or function or synergism is a requirement of patentability. It was emphasized that “under this standard one would focus solely on the product created rather than on the obviousness or nonobviousness of its creation, as required under §103.” In re Dillon, 892 F.2d 1554, 13 USPQ2d 1337 (Fed. Cir. 1989) (quoting, General Motors Corp. v. U.S. International Trade Commission, 687 F.2d 476, 482-83, 215 USPQ 484, 489 (CCPA 1982)); *See also* In re Spinnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) (“A patentable invention may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.”). Consequently, the Applicants respectfully submit that when considering obviousness, the Applicants’ claimed invention should be reviewed for obviousness of the creation, as opposed to the obviousness of the device. The Applicants respectfully submit that nothing in US ‘380 makes the creation of the Applicants’ fuse box obvious. In fact, the Applicants submit that the design of the device in US ‘380 is not appropriate for the inclusion of a pivotally mounted lower frame. Hence, the creation of the Applicants claimed invention would not be apparent to one of ordinary skill in the art upon review of US ‘380.

Moreover, the Applicants respectfully submit that it would not be obvious to modify the junction box of US ‘380 to include a hinge arrangement between the lower cover and the frame. The junction box of US ‘380 discloses a lower housing 43 which has a circuit board 51 affixed

thereto. US '380 states that “a circuit board 51 is internally disposed in housings 41 and 43 and maintained in place between standoffs 53 integrally formed with housings 41 and 43.” See Column 2, lines 52-54 of US '380. Consequently, the lower housing of US '380 is integrally formed with a circuit board affixed to the lower housing. In sharp contrast, the lower cover (8) of the Applicants' fuse box is pivotally detachable from **all** of the electric components, as illustrated in Fig. 2. This allows access to all of the electronic components from either an upper or lower position. US '380 does not teach or suggest a device that enables access to all of the electronic components. The Applicants have not created a device that, as asserted in the Office Action, is a “mere duplication of the essential working parts of a device.” Rather, the Applicants have created a novel electrical fuse box with pivotally mounted upper and lower covers that allow access to electronic components. In particular, as to the lower cover, the pivotal aspect is essential so as to enable later access to the connector modules to insert the electrical wires into the terminals. The lower cover 8 also serves to protect and guide the wires after harness assembly (paragraph 26). In contrast, US '380 does not require opening of its “lower cover” 43 to either access the “connector modules” 27 or to insert “wires” 15, as both the “connector modules” 27 and “wires” 15 in the '380 reference are readily accessible as they are located on the outside of its “lower cover” 43, as clearly shown in Fig. 2. Further, the “lower cover” 43 in the '380 reference can not operate to protect “wires” 15, since these elements are exposed. This exemplifies that there is no motivation to provide any type of pivotal “lower cover” 43.

The mere fact that prior art **can be** modified does not make the modification obvious unless the prior art suggests the desirability of the modification. In the instant case, it does not. The Applicants submit that US '380 fails to suggest the desirability of modifying the device of US '380 to isolate the electronic components from the pivotally mounted lower cover, to allow a

later installation of electrical wires by opening the lower cover, and by protecting and guiding of the wires in a closed position of the lower cover.

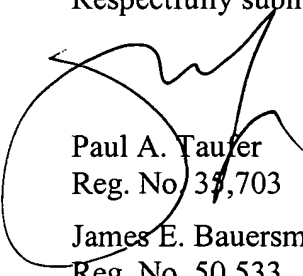
We invite the Examiner's attention to In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), wherein the Court of Appeals for the Federal Circuit made it clear that a prior art reference must be given a fair reading and that the reference must provide motivation to one of ordinary skill in the art to employ the apparatus of the prior art in the manner performed by the applicant. The Court specifically stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

This position by the Court of Appeals by the Federal Circuit has been confirmed in In re Mills, 16 U.S.P.Q. 2d 1430, 1432 (Fed. Cir. 1990). Both Gordon and Mills apply in this case wherein US '380 fails to suggest the desirability of making the hypothetical modification of adding a pivotally mounted lower cover or that any benefit would or could be realized upon doing so. Accordingly, the Applicants respectfully request withdrawal of the rejection of Claims 7, 14-18, and 25 as obvious in light of US '380.

In view of the foregoing, the Applicants respectfully requests allowance of the present application.

Respectfully submitted,


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PAT/JEB/ers
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